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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Seiki Aguro	Docket No.:	TIJ-26495
Serial No.:	09/281,042	Art Unit:	2123
Filed:	03/30/1999	Examiner:	Jones, H.
For:	COMPUTER SYSTEM	Confirm. No.:	6678

Petition to the Commissioner of Patents
Under 37 C.F.R. § 1.181

MAILING CERTIFICATE UNDER 37 C.F.R. §1.8(A)
I hereby certify that the above correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231.

William B. Kempler 7/1/02
William B. Kempler Date:

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

Applicants petition the Commissioner to exercise his authority and enter the Appeal Brief enclosed herewith or, in the alternative to decide the issue of the Examiner's requirements relating to the duty of disclosure and to strike that portion of the Appeal Brief.

The Examiner issued an Official Action mailed 6/03/2002 as a Notification of Non-Compliance with the Requirements of 37 C.F.R. 1-192(c). In response to the formal aspects of the Appeal Brief, Applicants submit a Revised Appeal Brief herewith. However, the Examiner states that the issue regarding his requirements relating to the duty of disclosure is petitionable under 37 C.F.R. 181 and not appealable.

We cannot agree. The Examiner states in both the first Official Action and the Final Rejection that:

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"Furthermore, Applicant's invention has been disclosed as part of IEEE Standard 1149.1" (First Official Action, page 2, paragraph 1; Final Rejection, page 2, paragraph 1).

In the first Official Action, the Examiner cited the reference as of interest only (page 5, paragraph 10) and rejected no claims in view of this Standard. In the Final Rejection there was no rejection of any claim in view of this reference. Nevertheless, the Examiner's statements remain on the record and act as a defacto prior art rejection of all claims in the application. Applicant does not see how the application can be passed to issue, even if Applicant is victorious before the Board of Patent Appeals and Interferences, without this issue being resolved. In view of the fact that this is a prior art rejection, albeit a "back-door" rejection, it should be decided by the Board and the Appeal Brief should be entered.

If the Commissioner decides that this issue is a petitionable rather than appealable issue, Applicants request that the Commissioner consider this a petition therefor. It should be noted that this Petition is within two months of the Examiner's action and thus within the term to file a petition under 37 C.F.R. § 181. The issue may be struck from the Appeal Brief, or, if necessary, Applicants will provide a revised Appeal Brief. The arguments regarding this issue are in the Revised Appeal Brief, but are repeated here for the convenience of the Office:

Information Disclosure Statement

The Examiner states that "Applicant has referred to scan circuits and ICE systems in the Background of the Invention, but has not provided an IDS . . . . Applicant has also admitted that Fig. 4 represents a prior art teaching - thus, admitting that Applicant is aware of specific prior art teachings. Furthermore, Applicant's invention has been disclosed as part of IEEE Standard 1149.1. It is presumed that Applicant is of at least ordinary skill in the art and therefore presumably aware of said standard.". In the Official Action of 10/24/2000, the Examiner asked if the Representative was aware of other relevant art. In the Final Rejection of 06/19/2001, the Examiner stated, in italics, that "the Applicant should

provide the office with copies of pertinent art in any response to this action.". The Examiner rejected the undersigned's statement, in the Response to the first Official Action, that neither he nor the inventor were aware of closer prior art that would be material to the examination of the application. He also rejected the statements made in the Response to the Final Rejection and the IDS filed therewith.

Applicants traverse the Examiner's statements regarding the requirements for an IDS and regarding the Standard. Even the Examiner does not believe his statement regarding the Standard and has admitted that the present invention is not shown in the IEEE Standard. In the first Official Action, dated October 24, 2000, the Examiner cited this Standard as prior art made of record and not relied upon. Therefore, the Examiner's Action contradicted his own statements. Furthermore, in the Final Rejection, the Examiner did not reject even a single claim in view of this Standard. Therefore, it is clear that the Examiner does not believe his own statements that the invention has been disclosed as part of the Standard.

The requirement for the duty of disclose information material to patentability is found in 37 CFR § 1.56 and the requirements for an IDS are found in 37 CFR § 1.97 and 1.98. Under 37 CFR § 1.56, information to be cited in "information known to that individual to be material to patentability as defined in this section". 37 CFR § 1.56(b) defines information that is material to patentabiity as not being cumulative to information already of record or being made of record and "(1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of the Claim; or (2) It refutes or is inconsistent with, a position the Applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability."

The Examiner has argued that the IEEE Standard is a reference that Applicant should have cited in an IDS. However, it is clear from the Examiner 's actions that this reference does not meet the requirements for materiality discussed above. The Examiner did not apply this reference against any Claim in either Official Action nor use the Standard

to reject any argument for patentability or reject any argument opposing an argument for unpatantability relied on by the Office that Applicant has made. Therefore, the Examiner, by his actions, has shown that this reference is not material to the invention defined by the present or the cancelled claims. The Examiner also alludes to the Background of the Invention section and Figure 4 of the present application. The inventor informs us that Figure 4 is not taken from the IEEE Standard because the Standard has no description of the emulation logic, but is an abstract image of emulation logic and scan-path interface logic accessed by an emulator. An IDS requires the citation of a specific reference.

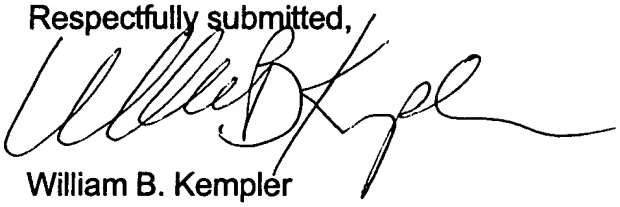
Secondly, the Examiner states that he is aware of and obtained numerous examples of such teachings. Applicant is pleased that the Examiner has performed a thorough search of the art as that is the only way they will receive a strong patent. However, finding these references is the Examiner's job and not Applicant's. Furthermore, the Examiner has signed the Official Actions as "Dr." which presumably means he has a Ph D. Accordingly, even if he thinks that the inventor is of ordinary skill in the art, he may be at a much higher level, which should not be used to place additional burdens on Applicant or draw negative inferences therefrom.

Applicants did submit an IDS containing two references that the inventor searched for, in the Response to the Final Rejection.

Accordingly, Applicants request that the Examiner's requirements regarding the Information Disclosure Statement and the implications therein, as well as his comments regarding the disclosure of the present invention be withdrawn.

Please charge the petition fee to Deposit Account No. 20-0668 of Texas Instruments Incorporated. A copy of this Petition is enclosed.

Respectfully submitted,



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